



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/335,714 06/18/99 LACEY D 4007-8007

QM22/1031

KEVIN C. BROWN
BURR & BROWN
P.O. BOX 7068
SYRACUSE NY 13261-7068

EXAMINER

YU, J

ART UNIT

PAPER NUMBER

3764

DATE MAILED: 10/31/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/335,714

Applicant(s)

Lacey

Examiner

Justine Yu

Group Art Unit

3764

☒ Responsive to communication(s) filed on Aug 21, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4 and 6-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 and 6-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Aug 21, 2000 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3764

DETAILED ACTION

1. This office action is responsive to the amendment filed on 8/21/00. As directed by the amendment, claims 1-4 and 6-11 were amended, claim 5 was canceled, and claims 12-20 were added. Thus, claims 1-4 and 6-20 are presently pending in this application.

Claim Rejections - 35 USC § 112

2. Claims 1-4 and 6-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 6-7 the term "smaller than said head" is vague and indefinite.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 10-16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Rowe (Pat. No. 836,217).

Art Unit: 3764

Rowe teaches a forceps comprising a plurality of resilient fingers 9 defining a head receiving space, at least a portion of the head receiving space having a circumference which is greater than a circumference of an opening formed by the free ends 15, see figure 2.

Regarding claims 2 and 13, notes the pliable fingers in figures 1 and 2 of Rowe.

Regarding claims 3, 4, 14 and 15, notes the bulb or ball structure 15 in figures 2 and 10 of Rowe.

Regarding claims 6 and 16, notes the wires 9 in figures 2 and 3 of Rowe.

Regarding claims 10, 11, and 20, notes the opposite ends of the fingers terminated in a handle 11, see figure 3 of Rowe.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7-9 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowe.

Regarding claims 7, 8, 17, and 18, Rowe does not explicitly disclose that the fingers being made of electrically conductive material. However, the feature of choosing an electrically conductive material, i.e., metal for the wire is considered as an obvious design choice since the

Art Unit: 3764

electrically conductive material is a well known material in the forceps art. In addition, the feature of fabricating the fingers from copper wire is considered as an obvious design choice within the knowledge of one skill in the art, in order to provide enough strength and including a certain degrees of flexibility in the fingers which preventing the body part from being damaged.

Regarding claims 9 and 19, Rowe teaches three fingers but lacks 4-24 fingers. However, duplicating the components of a prior art device is a design consideration with in the skill of the art. Furthermore, the feature of having more than three fingers, i.e., four or five fingers is well known in the art.

Response to Arguments

7. Applicant's arguments with respect to claims 1-4 and 6-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Read (Pat. No. 835,688) and Hanson (Pat. No. 1,151,583) are cited to show forceps having multiple fingers.

Art Unit: 3764

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justine Yu whose telephone number is (703) 308-2675. The examiner can normally be reached on Tuesday - Friday from 8:30 AM - 6:00 PM. The examiner can also be reached on alternate Mondays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Application/Control Number: 09/335,714

Page 6

Art Unit: 3764

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Everett Williams whose telephone number is (703) 305-1708.



Justine Yu

October 25, 2000